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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/062,131

02/01/2002

John C. Russell

6885.US.O1

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03/07/2005

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EXAMINER

CEPERLEY, MARY

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/062,131

**Applicant(s)**

RUSSELL, JOHN C.

**Examiner**

Mary (Molly) E. Ceperley

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,19,20,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,19,20,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**1)** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**2)** Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Yu et al (US 6,592,105) for the reasons stated in paragraph **6)** of the July 27, 2004 Office action.

Applicant's arguments filed December 20, 2004 have been fully considered but they are not persuasive. In the Remarks of page 6, first paragraph, applicant alleges that there is a distinction between the method of instant claim 1 and the method of the Yu et al patent in that in Yu et al there is no covalent bond between the First Macromolecule and the Second Macromolecule. However, Yu et al does in fact describe a covalent bond between the First Macromolecule and the Second Macromolecule at column 12, lines 61-63 wherein "some amino acids may be coupled to one another forming an oligopeptide prior to addition of the oligopeptide to the growing solid phase polypeptide chain". Thus, Yu et al does in fact describe a covalent bond between the First and Second Macromolecules.

**3)** Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu et al (US 6,592,105) for the reasons stated in paragraph **7)** of the July 27, 2004 Office action.

The statements made in the paragraph above (rejection of claim 1 under 35 USC 102(e)) apply to this rejection as well. Applicant has not addressed this rejection separately from the rejection of claim 1 (see the Remarks of December 20, 2004, page 6, second and third paragraphs).

**4)** Claims 1, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz (US 2003/0013857 A1) for the reasons stated in paragraph **8)** of the July 27, 2004 Office action.

Paragraph **8)** of the July 27, 2004 Office action clearly sets forth the examiner's interpretation of the method described by Schwartz. Applicant's argument at page 6, fifth and sixth paragraphs of the December 20, 2004 Remarks is merely a statement of what Schwartz "does not disclose". Applicant has

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not addressed the examiner's assertions, addressed how the instant claims differ from Schwartz nor provided a discussion of applicant's position relative to the statements made by the examiner.

**5)** Claim 1 is rejected under 35 U.S.C. 103(a) as being obvious over Merrifield (AK) for the reasons set forth in paragraph **10)** of the July 27, 2004 Office action.

Applicant argues that "because individual amino acids are not macromolecules, it is submitted that Merrifield does not render claim 1 obvious". However, applicant does not rebut the examiner's statement and reasoning regarding the obviousness of amino acids versus proteins and polypeptides as set forth in the third subparagraph of paragraph **10)** of the July 27, 2004 Office action.

**6)** Claims 19, 20, 26 and 27 are rejected under 35 USC 102/103 as being anticipated by or obvious over each of Xu et al (US 6,737,240), Rice et al (US 6,759,036), or Cook et al (US 6,753,423).

Each of the references describes a conjugate of an antibody (First Macromolecule) with phycoerythrin (Second Macromolecule), a chromophore, present in solution or suspension. Independent of how these soluble or suspended conjugates were prepared, the products of the prior art which contain an antibody-phycoerythrin conjugate appear to be the same as the "suspended or soluble protein conjugates" of the instant claims (see in particular, the phycoerythrin conjugate of instant claim 27). See Xu et al: col. 45, lines 5-12; Rice et al, col. 6, lines 2-14; Cook et al: col. 45, lines 37-51.

For a discussion of product by process claims, see MPEP 2113.

**7)** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 04, 2005



Mary (Molly) E. Ceperley  
Primary Examiner  
Art Unit 1641